

S/N 10/522,208

PATENT

In The United States Patent and Trademark Office

Applicants: Mezher Hussein Ali

Examiner: Celia C. Chang

Serial No.: 10/522,208

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For: PIPERIDINETRIOL DERIVATIVES AS
INHIBITORS OF GLYCOSYLCERAMIDE
SYNTHASE

Attorney Docket No.: AC-21-US

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This is in response to the non-final office action Restriction Requirement mailed on July 29, 2008:

The examiner issued a restriction as follows:

Group I, claims 3-6, 11, drawn to compounds wherein R is C₁₋₃alkylAr¹, Ar¹ is substituted phenyl. If this group is elected, a further election of a single disclosed species is also required. Claims 1-2, 7-10, 13-14 reading on the elected compounds can be prosecuted together with the election to the extent of the election.

Group II, claims 1-2, 7-10, 13-14, drawn to compounds wherein R is C₁₋₃alkylAr¹, Ar¹ is substituted pyridyl. If this group is elected, a further election of a single disclosed species is also required.

Group III, claim 15, drawn to method of inhibiting glucosylceramide synthase in a patient, If this group is elected, a further election of a single disclosed compound for inhibiting the enzyme is also required.

Group IV, claim 16-17, drawn to method of treating glycolipid storage disease. If this group is elected, a further election of a single disclosed compound for treating a single disclosed disorder is also required.

Group V, claim 18, drawn to method of treating Niemann-Pick disease type C, mucopolysaccharidosis type I, mucopolysaccharidosis type IIIA, mucopolysaccharidosis type IIIB, mucopolysaccharidosis type VI, mucopolysaccharidosis type VII, o~-mannosidosis or- -and mucolipidosis type IV in a patient. If this group is elected, a further election of a single disclosed compound for treating a single disclosed disorder is also required.

Group VI, claims 19-20, drawn to method of treating cancer. If this group is elected, a further election of a single disclosed compound for treating a single disclosed specific cancer is also required.

Group VII, claims 21, drawn to method of treating, Alzheimer's disease, epilepsy, stroke, Parkinson's disease or spinal injury in a patient. If this group is elected, a further election of a single disclosed compound for treating a single disclosed disorder is also required.

Group VII, claim 22, drawn to method of treating microorganism infection. If this group is elected, a further election of a single disclosed compound for treating a single disclosed species of microorganism infection is also required.

Group VII, claim 23, drawn to method of treating disease associated with abnormal glycolipid synthesis in a patient. If this group is elected, a further election of a single disclosed compound for treating a single disclosed disorder is also required.

Group IX, claims 24-25, drawn to method of treating a condition treatable by administering ganglioside. If this group is elected, a further election of a single disclosed compound for treating a single disclosed disorder is also required.

Group X, claim 26, drawn to method of reversing male infertility in a mammal. If this group is elected, a further election of a single disclosed compound for the method is also required.

Group XI, claim 27, drawn to method of treating obesity in a patient. If this group is elected, a further election of a single disclosed compound for treating obesity is also required.

Group XII, claim 28-29, drawn to method of treating inflammatory diseases. If this group is elected, a further election of a single disclosed compound for treating a single disclosed inflammatory disorder is also required.

Group XIII, claim 30, drawn to compounds of formula III. If this group is elected, a further election of a single disclosed species is also required.

The Examiner argued that these claims do not relate to a single general inventive concept under 35 USC 121 or PCT Rule 13.1.

Applicants respectfully traverse. Applicants refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs the Examiner that if the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits.

M.P.E.P. § 803.

In this case, the entire scope of the claims has already been searched by the International Search Authority, without any objection as to unity of invention, thus for the Examiner to review and confirm this search should not entail a serious burden. Under these circumstances, the Examiner has not explained why a search of the scope of claim 1 would entail a serious burden, particularly as compared with the Examiner's proposal to divide the case into thirteen (13) separate filings, which obviously would place a far greater burden on the resources of both the Applicants and the PTO. Moreover, the Examiner has not explained why the claims to processes of making or using compounds of claim 1, which are already dependent on claim 1, must nevertheless be restricted.

The Restriction Requirement should be withdrawn.

Should the Examiner nevertheless maintain this restriction requirement, and reserving all rights, including the right of rejoinder should a generic claim prove allowable and the right to pursue divisional or other filings on non-elected subject matter,

Applicants provisionally restrict to

Group I, claims 3-6, 11, drawn to compounds wher n R is C₁₋₃alkylAr¹, Ar¹ is substituted phenyl (Claims 1-2, 7-10, 13-14 reading on the elected compounds can be prosecuted together with the election to the extent of the election)

and provisionally elect the species of Example 11 for further examination.

Applicants respectfully submit that this application is in condition for examination and allowance. If any additional fees are required or if an overpayment has been made, the

Commissioner is authorized to charge or credit Deposit Account No. 50-4255. Should there be any questions, the Examiner is respectfully invited to telephone the undersigned.

Respectfully submitted,

Date:

August 29, 2008


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